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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,605	09/27/2001	Edgar Pau	3251/FBR	4654
26304	7590	06/01/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			MOSSER, ROBERT E	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
			3714	
DATE MAILED: 06/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,605

Applicant(s)

PAU ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-30-2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-4 and 6-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4 and 6-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION



In response to the amendment filed November 30th, 2004 claims **1** through **4** and **6** through **20** are pending.



Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim **20** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The theoretical return of a base game being increased by a bonus game. Is not reasonably provided for in the specification as filed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-4, 6-9, 12, and 14-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573).

Regarding claim 1, O'Halloran teaches a gaming machine with display means (Element 20) and control means (Element 32) being disposed to play an underlying game with underlying prizes associated with the underlying game (See Figure 2) wherein on the occurrence of a predefined event or triggering event (See Col 1:49) the player is enters a second game in which a common game type with two or more game choices is provided (See Col 1:50-51 & Col 2:12-24). O'halloran further discloses the second game in which the player selects a card from a row of cards and where further the chance of the player selecting a card that would yield a winning out come is inversely proportional to the number of card per the row selected thus indicating a

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random assignment of the winning card as so claimed (See Col 2:16-24 & Figures 4 and 5),

O'Halloran further teaches allowing the player to choose only one prize set as so claimed in the players selection of the eight of spades second set in Figure 5 for example. The previous selection made immediately following the start off the bonus round results in the selection of one prize set and a selection of a non-winning outcomes or equivalently elements (*Eight of spades shown in figure 5 & Col 3:66-4:3*) that in turn ends the bonus game, wherein as understood the bonus game only continues upon a win in the bonus game (Col 3:62-65).

The claimed "total theoretical return to the player is the same regardless of the prize the player chooses" is an inherent feature of gaming devices in that a fixed total theoretical return is required by gaming law or gaming regulations as per the applicants arguments on page 6 of paper 11.

O'Halloran is silent on including bonus game prizes that are independent of the prize awarded in the underlying game and the displaying of at least two winning outcomes within at least one of the prize sets.

Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set size of multiple winning outcomes and a non-winning outcome that further spin randomly before stopping on a segment so as to define a prize won, which is independent of any prize awarded in the underlying game and upon

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defining the prize won the several other possible prize outcomes are displayed to the user (See Figures 4 & 6).

It would have been obvious to one of ordinary skill in the art at the time of invention to included prizes that are independent of the prize awarded in the underlying game of O'Halloran and the displaying at least two winning outcomes within at least one of the prize sets thereof, in light of the teachings of Baerlocher et al, in order to avoid player perception of being penalized for getting a bonus event on a small win in the underlying game or alternatively give the player the perception of a greater amount of total prize possibilities in a similar fashion to the spinning of the reels of a traditional slot machine.

Regarding Claims **2-4** and in addition to the above stated. O'Halloran teaches one winning outcome or the Joker card being presented per row or prize set and at least one non-winning outcome being presented per row or prize set (See Figure 5). This corresponds to one or more prize outcomes, which are identical in the same prize set or in a different prize set (See the middle and bottom rows of cards in figure 5) where in the identical prize outcomes are the non-winning outcomes represented via the non-Joker type playing cards.

Regarding claim **17** and in addition to the above stated. Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set

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size and spin randomly before stopping on a segment that defines a prize won (See Figures 4 & 6).

Regarding claims **6-8** and in addition to the above stated. O'Halloran teaches the use of a combination of symbols appearing on the win lines of a spinning reel game of chance for the purposes of triggering a game feature (See Col 3:15-21). This corresponds to the occurrence of a special combination in claim 6 as presented, the triggering of a game feature (triggering event as so claimed) at random in claim 7 as presented where in the random triggering is due to the random alignment of the trigger event or winning combination on a reel game, and a spinning reel game as presented in claim 8 (See Figure 2).

Regarding claim **12** and in addition to the above stated. O'Halloran teaches the presentation of each prize set distinctly as each prize set as so claimed is presented herein as a row of cards (See Figures 4 and 5).

Regarding claims **9**, and **14-16** and in addition to the above stated. O'Halloran teaches the presentation of player selectable prize sets that includes: winning and non-winning outcomes and identical prize outcomes located between sets and located within the same prize set but is silent on the use of segments on a spinning wheel to define the prize outcome. Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or

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simulations thereof that spin randomly before stopping on a segment that defines a prize outcome won by the player (See Figure 6). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the multiple spinning wheels or simulations thereof that spin randomly before stopping on a segment that defines a prize outcome as taught by Baerlocher et al in the invention of O'Halloran in order to suit the theme of the bonus game being played or adapt an existing bonus game to a machine with a wheel theme.

Regarding claims **14-16**, and **19** and in addition to the above stated, O'Halloran teaches the presentation of player selectable prize sets that includes: winning and non-winning outcomes and identical prize outcomes located between sets and located within the same prize set but is silent on the inclusion of multiple different wheels, wherein the display means displays the two or more different wheels simultaneously and wherein once a wheel is selected by the player, said wheel is enlarged relative to any non-selected wheels. However in addition to the above Baerlocher teaches the enlargement and display of the wheel in play with respect to those wheels not currently in play (See Figure 4). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the enlarged displaying of a selected wheel as taught by Baerlocher et al in the invention of O'Halloran in order to suit the theme of the bonus game being played or adapt an existing bonus game to a machine with a wheel theme.

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Claims **10**, **11**, **13**, and **18** are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573) in further view of DeMar et al (US Pat 6,315,660).

The combination as taught by O'Halloran/Baerlocher et al taught above is silent regarding the use of dice as the three dimensional object and the use of a board game representations as so claimed. DeMar et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates a board game feature (Element 62) wherein a random role of dice (Element 64) or simulation thereof (Element 43) determine the distance traveled on the board and the prize outcome (See Figures 1,6,8,13,16B, and 24). Further as presented in at least claim **11** the prizes defining the faces of the dice corresponds to the number shown on the dice of DeMar and corresponding prize associated with the resultant board position of the player piece/game token combined with the display of the prize values that define segments of a wheel as presented in Baerlocher et al and shown above.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the use of dice as the three dimensional object in game representation in the game as taught by O'Halloran/Baerlocher, in light of the teachings of DeMar et al, in order to extend the period of player anticipation through giving the impression that they are watching the determination of the game result in a similar fashion to the spinning of the reels of a traditional slot machine.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573) in further view of DeMar et al (US Pat 6,203,429).

In addition to the above stated the combination of O'Halloran/Baerlocher is silent regarding the theoretical return of a base game being increased by a bonus game however in a related gaming machine DeMar teaches the theoretical return of a base game being increased by a bonus game (DeMar Col 7:1-37). IT would have been obvious to distribute the theoretical return in the manner shown by DeMar in the combination of O'Halloran/Baerlocher in order increase player anticipation and "endurance" of the base game (DeMar Col 8:26-37).

Response to Arguments

Applicant's arguments filed November 30th, 2004 have been fully considered but they are not persuasive.

Applicant's remarks starting on paragraphs five and six of page number seven, address cumulative return to player percentage (RPP) and in particular point to the "the RPP of only the underlying game may be reduced while the RPP of the underlying game and the secondary game may still meet statutory/regulatory requirements". Arguments presented therein are not commensurate in scope with presented claims 1-4 and 5-20. Specifically there is no presented correlation between the differentiation between the RPP of the base game and the bonus game and the claims as presented.

In so much as these remarks address the newly added claim 20 they have been address in the rejection of said claim above.

Applicant's arguments starting on the second full paragraph of page eight and incorporating the declaration of Mr. Pau addresses features (The separation RPP of the base and bonus game and the neutral effect of the bonus game of O'Halloran) of the not presently claimed in all but the newly presented claim. In so much as they are now presented they have been addressed in the rejection of claim number 20 above.

As presented and clarified by the applicant's representative the examiner concedes that the effect on RPP for solely the bonus game of O'Halloran as presented does indeed contain a neutral effect. The declaration of Mr. Pau however, appears to support the original combination as presented for the teaching of a claimed "total theoretical return to the player is the same regardless of the prize set the player chooses" when one considers the bonus game as having a neutral effect on RPP. Remaining considerations including the suggestion of a destructive combination are not presently supported by evidence on the record

In closing, the issue of game return and functionality between the prior art and the claimed invention appears to be making some forward progress the incorporation of these feature into the claims and as supported by the specification as originally filed appears to only now starting with the introduction of claim 20. However it is uncertain that what may be equated to the alteration of odds, a return player percentage, or a house take, over a series of games would present in terms of novelty when such considerations and the balancing thereof are a required consideration in the design of

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any multi-tier or multiple wager game. The preceding concern is believed to be well reflected in the rejection of the newly presented claim 20 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

REM

A handwritten signature in black ink, appearing to be 'JA' followed by a long horizontal stroke.

JESSICA HARRISON
PRIMARY EXAMINER